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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/368,503	08/05/1999	LARREN F. JONES	51291.81516	5616

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EXAMINER

BATSON, VICTOR D

ART UNIT	PAPER NUMBER
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3671

DATE MAILED: 09/10/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/368,503

Applicant(s)
JONES ET AL.

Examiner
Victor Batson

Art Unit
3671



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 21, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-73 is/are allowed.
- 6) ☒ Claim(s) 74-118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Copy of Patent

1. The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Reissue Applications

2. Claims 74-118 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application. The subject matter previously surrendered during the prosecution of

the application includes the ***T-shaped*** structure and the ***adjustment assembly selectively movable to vary the relative positions of the first and second faces*** to eliminate looseness which may exist in mounting said wear member as set forth in amendment A.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims [✓]74-80, [✓]84-87, [✓]108-110, [✓]111, [✓]112 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones (5,088,214).

Jones '214 discloses a wear assembly having all of applicant's claimed structure including a mount (considered boss 29), a wear member including a second shoulder and an opening, and a lock 38 received in the opening in the wear member to prevent disconnection of the first and second shoulders and thereby retain the wear member to the mount as shown in figure 10. Jones '214 also discloses a keeper assembly 45.

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✓ 5. Claims 88-90, 115, 117, 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones (5,088,214) in view of Jones et al. (4,433,496).

Jones '214 discloses a wear assembly having essentially all of applicant's claimed structure as described previously, but lacks the lock including an adjustment assembly movable to tighten the fit of the lock between the wear member and the mount.

Jones et al. '496 teaches that it is known in the art to use a lock including an adjustment assembly movable to tighten the fit of the lock and eliminate looseness in the wear assembly.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made, to modify the wear assembly of Jones (5,088,214) by using a lock with an adjustment assembly as taught by Jones et al. '496, to eliminate looseness in the wear assembly.

Allowable Subject Matter

6. Claims 1-73 are allowed.

Response to Arguments

7. Applicant's arguments filed 5/21/02 have been fully considered but they are not persuasive.

Recapture

Applicant argues that the term "T-shaped structure" is not used in any of claims 74-118 and therefore the claims can not be improper on the basis of recapture. It is the examiner's position that claimed limitations referring to T-shaped structure (which includes for example "T-shaped structure", "T-shaped coupling structure", "T-shaped slot"), was originally presented, argued and stated in the original application to make the claims allowable over a rejection made in the original application (amendment A, paper #9). As argued by applicant, these limitations have been omitted in the present independent claims. Therefore, the omitted limitations relate to subject matter previously surrendered by applicant, and is therefore impermissible recapture. Applicant uses similar arguments regarding the adjustment assembly limitation. Therefore, similarly, regarding the limitation of an "adjustment assembly selectively movable to vary the relative positions of the first and second faces", this **adjustment** limitation is clearly argued in the original application (amendment A, paper #9) as defining over the prior art, with independent claim 1 being amended to include the limitation (see also claim 51). It is noted that recapture relates to applicant attempting to broaden claims in a reissue application by omitting limitations that made the claims

of the original application allowable over a rejection or objection. Therefore, since the omitted limitations have not been added, the rejection of claims 74-118 under 35 U.S.C. 251 has been maintained.

New Matter

In view of applicant's amendments and the arguments regarding the "one-piece boss", the previous New Matter objection has been dropped.

Prior art arguments

Applicant argues that the assembly in the '214 patent does not include an inner surface that is bent or fixed along the front of the digging edge, which is recited in claim 74. The examiner disagrees as boss 29 clearly has a bent surface (considered the rounded surface), and the surface that the boss is connected to is considered a face of the lip and the front of the digging edge.

Applicant argues that claim 75 recites that the boss further includes a front support surface that abuts the wear member to restrict rearward movement of the wear surface, which is not disclosed in the '214 patent. The examiner disagrees as figure 2 shows the upper forward edge of boss 29 abutting the wear member. Additionally, since the forward edge of boss 29 is arcuate in shape, applicant's arguments regarding claim 76 are not persuasive.

Applicant argues that claim 81 recites that the front structure of the boss wraps around the digging to define a second leg which is not disclosed by '214. The examiner notes that claim 81 appears to recite that the **wear member** not the boss, wraps around the digging edge. If as applicant argues, "the front structure" is referring to the boss, then it is unclear what the rear structure of the wear member" is referring to since the boss is defined as having a rear structure in claim 74, but the wear member is not. Since claim 74 does set forth the boss as having a rear structure, applicant's arguments regarding claim 81 are considered persuasive, however an explanation regarding what the "rear structure of the wear member" is referring to in claim 81 line 2 is required. Accordingly, the prior art rejection of claims 82 & 83 have been dropped.

Concerning applicant's arguments regarding claim 87, rear recess 60 is considered the stem portion.

Applicant's arguments regarding claims 91, 103, 113, 114 are considered persuasive. Accordingly, the previous prior art rejection of claims 91-110,114 has been dropped.

Concerning applicant's arguments regarding claim 111 & 112, the inner surface of boss 29 in the '214 patent is considered to meet the limitation of the inner surface being bent and adapted

to be fixed along a face of the lip and front edge as described above.

Applicant's arguments regarding claims 88-90 are not persuasive since the '214 patent is considered to meet the limitations of claim 74.

Concerning claims 100-102, & 104-106 the arguments are considered persuasive.

Applicant further argues that the '496 patent is a much different structure and includes a locking arrangement which operates in a different manner than the lock in the '214 patent and therefore it would not be obvious to one of ordinary skill in the art to adjust the front and rear faces of the lock in the '214 patent to eliminate any looseness which may exist in mounting the shroud to the digging edge. The examiner disagrees since both the '214 patent and the '496 disclose locking devices for locking excavating type teeth to a digging edge.

Final Rejection

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is

not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

9. Any inquiry concerning this communication should be directed to Examiner Victor Batson whose telephone number is (703) 305-6356. The examiner can be normally reached Monday through Friday (except Wednesday) from 7:00 am to 5:00 pm, Eastern Standard Time.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Will, can be reached on (703) 308-3870. The fax phone number for this Group is (703) 305-3597.

August 9, 2002



Victor Batson
Primary Examiner
Art Unit 3671